

REMARKS

I. Overview

These remarks are set forth in response to the New Non-Final Office Action. Presently, claims 1, 3 through 8 and 10 through 15 are pending in the Patent Application. Claims 1, 5, 8 and 12 are independent in nature. In the New Non-Final Office Action, claims 1, 3 through 8 and 10 through 15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,816,902 to Bandat et al. (Bandat) in view of Eugene Deborin et al., CONTINUOUS BUSINESS PROCESS MANAGEMENT WITH HOLOSOFX BPM SUITE AND IBM MQSERIES WORKFLOW, IBM Redbooks (May 2002), hereinafter "Deborin", and further in view of Rajiv Dewan et al., WORKFLOW REDESIGN THROUGH CONSOLIDATION IN INFORMATION-INTENSIVE BUSINESS PROCESSES, hereinafter "Dewan". Claim 8 also has been rejected under 35 U.S.C. § 112, second paragraph for a minor informality which informality has been corrected by way of an amendment to claim 8.

In response, Applicants have amended claims 1, 3, 5 and 12 to clarify the sending of the new form to the participant such that the new form contains the consolidated information. Support for Applicants' amendment can be found in paragraph [0103] of Applicants' specification. Accordingly, no new matter has been added.

II. The Applicants' Invention

The Applicants' invention includes a workflow server connected with operating computer terminals through a network to manage workflow. The workflow server

consolidates information necessary for processing multiple consecutive nodes to be processed by one participant operating one of the operating computer terminals, and sends a form with the consolidated information to the operating computer terminal concerned for use by the participant in interacting with the workflow.

III. Rejections Under 35 U.S.C. § 103(a)

Examiner has rejected claims 1, 3 through 8 and 10 through 15 as being merely an obvious variation over Bandat, Deborin and Dewan. M.P.E.P. 2141 sets forth guidelines intended to assist personnel of the United States Patent and Trademark Office in making a proper determination of obviousness under 35 U.S.C. 103, and to provide an appropriate supporting rationale in view recent judicial developments in regard to 35 U.S.C. § 103. Included as part of M.P.E.P. 2141 are the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.," 73 Fed. Reg. 57,526 (2007) (hereinafter the Examination Guidelines). Section III of M.P.E.P. 2141 is entitled "Rationales To Support Rejections Under 35 U.S.C. 103." Within this section is the following quote from the Supreme Court: "rejections on obviousness grounds cannot be sustained by merely conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR Int'l Co., 127 S. Ct. 1727, 1741 (2007) (quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

In reviewing Examiner's analysis set forth on pages 4 through 9 of the New Non-Final Office Action, Examiner appears to have employed "rationale (A)" of the Examination Guidelines in attempting to set forth Examiner's prima facie case of obviousness. With respect to rationale (A), the Examination Guidelines set forth a precise process for which the Examiner must follow in order to establish a prima facie case of obviousness under 35 U.S.C. § 103(a). Specifically, to reject a claim based on this rationale, Office personnel must resolve the Graham factual inquiries. Thereafter, Office personnel must then articulate the following:

- (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;
- (2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately;
- (3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and
- (4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

When articulating a finding that the prior art included each element claimed in a rejected claim, however, as a first step the Examiner must establish a **proper construction of the claims**. In establishing a proper claim construction, though, the pending claims must be "given their broadest reasonable interpretation consistent with the specification,"¹ and the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.² Only subsequent to establishing a proper claim construction must the Examiner compare **the properly construed claim** to

¹ *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) ("[T]he PTO must give claims their broadest reasonable construction consistent with the specification. Therefore, we look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation."); *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

² *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999)

the prior art.”³ It is the position of Applicants that under M.P.E.P. 2141 and the Examination Guidelines set forth therein, Examiner has not adequately articulated a finding that the prior art included each **properly construed** element claimed with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.

Specifically, claim 1 (and similarly claims 5, 8 and 12) recites a workflow system and method (and also a workflow server and a workflow engine) for consolidating a workflow. For the convenience of the Examiner, exemplary claim 1 as amended is reproduced herein as follows:

1. A workflow system comprising:
operating computer terminals executing a workflow; and
a workflow server connected with said operating computer terminals in a network to manage the workflow, wherein said workflow server consolidates information necessary for processing in multiple consecutive nodes to be processed by at least one participant operating one of said operating computer terminals, wherein when a form to be circulated in the workflow reaches a first one of the multiple consecutive nodes to be processed by the at least one participant, said workflow server consolidates information necessary for the at least one participant's determination, and wherein **said workflow server generates a new form based on the consolidated information and sends the new form with the consolidated information to the operating computer terminal for use by the at least one participant in make the participant's determination.**

Integral to claim 1 (and claims 5, 8 and 12 by extension) is generation of a new form based on consolidated information and the sending of the new form with the consolidated information to a terminal for use by the participant. So much cannot be found in the combination of Bandat, Deborin and Dewan.

³ Medichem, S.A. v. Rolabo, S.L., 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

Notwithstanding, on page 8 of the New Non-Final Office Action, Examiner refers to page 19, 185 and 248 of Deborin for this teaching. Page 19 of Deborin provides an overview of application integration provided by message brokering software to implement workflows between applications. Page 185 pertains to the development of "To-Be" process documentation using a forms based user interface as more expressly set forth on page 182 of Deborin. Yet further, page 248 of Deborin discloses the conversion of the "To-Be" model into a workflow model useable by the message brokering system through the consolidation of tasks to be performed by the same role into a single activity. However, nowhere in Deborin can a teaching be found directed to the "generation" (e.g. creation) of a new form based upon the consolidated information. Rather, Examiner has only located piecemeal a teaching of a form used to define a model (and not a form generated from consolidated information) and a teaching of consolidating tasks into an activity (and not a form).

To the extent that this claimed critical teaching is absent from the combination of Bandat, Deborin and Dewan, the requirements of rationale (A) of M.P.E.P. will not have been satisfied and a prima facie case of obviousness will not have been made by Examiner.

IV. Conclusion

In that Bandat, Deborin and Dewan lack as a combination teachings claimed within independent claims 1,5, 8 and 12, Applicants respectfully request the withdrawal of the rejections under 35 U.S.C. § 103(a) owing to the amended claims and the foregoing remarks. The Applicants request that the Examiner call the undersigned if

clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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